



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/581,261

07/11/2006

Sven Kornfalt

8688.049.US0000

1815

74217

7590

04/08/2009

NOVAK, DRUCE + QUIGG L.L.P. - PERGO  
1300 Eye Street, N.W.  
1000 West Tower  
Washington, DC 20005

EXAMINER

O HERN, BRENT T

ART UNIT

PAPER NUMBER

1794

MAIL DATE

DELIVERY MODE

04/08/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/581,261	<b>Applicant(s)</b> KORNFALT ET AL.	
	<b>Examiner</b> Brent T. O'Hern	<b>Art Unit</b> 1794	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 February 2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Claims***

1. Claims 1-20 are pending.

## **WITHDRAWN REJECTIONS**

2. All rejections of record in the Office Action mailed 10/7/2008 have been withdrawn due to Applicant's amendments in the Paper filed 2/9/2009.

## **NEW REJECTIONS**

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-13 and 16-17 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The phrases "independently consisting of a decorative material" in claim 1, line 8 and claim 10, line 9 are not supported by the original disclosure.
4. Claim 12 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Art Unit: 1794

5. Claim 12 recites the limitation “the metal sheet” in line 1. There is insufficient antecedent basis for this limitation in the claim. Applicant deleted the metal sheet limitation in independent claim 1. Furthermore, the entire claim is broader than independent claim 1 since the materials of the surfaces in claim 1 are limited by the “consisting of” language.

Clarification and/or correction required.

***Claim Rejections - 35 USC § 102***

6. Claims 1-2, 7 and 12-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Grau (WO 03/060256) with evidence by Grau (US 2005/0115181). Grau ('181) is the English equivalent to Grau ('256).

Grau ('256) teaches a flooring system comprising a plurality of panels (See FIGs 2-3, 10-11 and 1, module #1 and tile #7.)

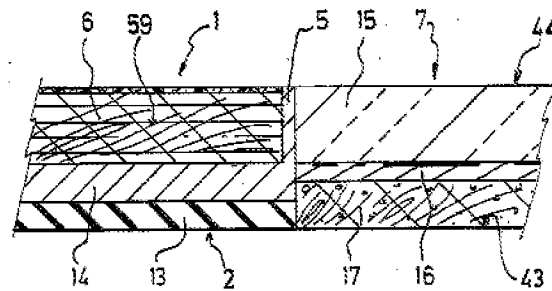


Fig 2

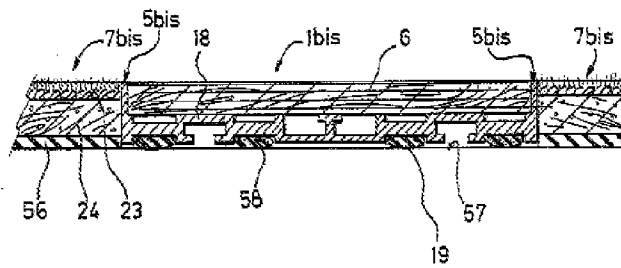


Fig 3

Fig 10

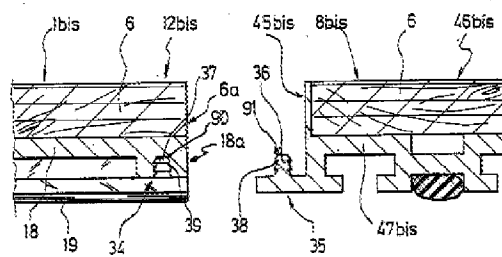
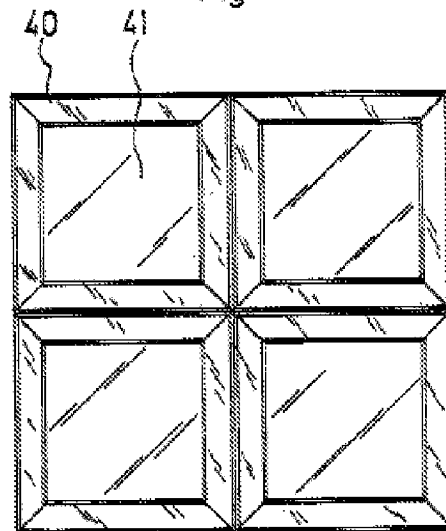


Fig 11



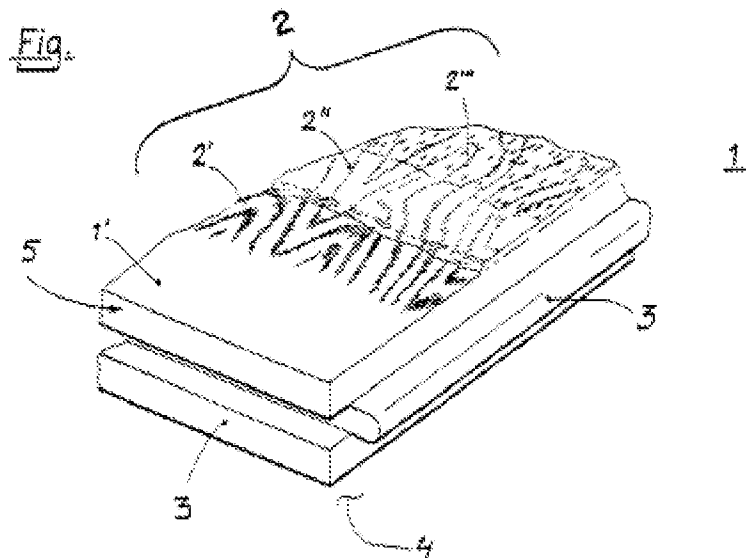
each panel/ (the panels) comprising a carrying panel provided with edges, the edges being provided with a snap-joining functionality, at least one panel differing in at least one of aesthetic or mechanical properties from another panel of the system, the carrying panels further being provided with an upper side and a lower side wherein the flooring

Art Unit: 1794

system comprises a plurality of panels where each carrying panel is provided with an upper decorative surface on the upper side of the carrying panel with a surface structure and the flooring system comprises panels having at least two of the decorative surfaces being different from each other and independently consisting of a decorative material selected from a mineral, a mineral composite, a thermoplastic composite or a fabric (See FIGs 2-3, 10-11, 1 and paras. 61-72, 81-84, 8, 44 as illustrated in FIG-2 and the other figures, module #1, with decorative lamina #6, receptacle for receiving lamina #59, lower web #14, square tile #7, glass #15 and decorative sheet #16. Fig-3 illustrates tiles #7bis with carpet #23. The materials can be minerals and/or mineral composites such as the metals aluminum and steel and glass, thermoplastic PVC or carpet. The surfaces of the panels are made of different materials. Claim 1 does not require each panel to only have one decorative surface and not two or more decorative surfaces. The claims do not require the materials of one surface to be different from that of another surface but rather for the system to have more than one panel and more than one surface. Two panels will have two physically different surfaces since they are different panels. FIG-10 illustrates the panels being joined by male and female members #35 and #34, respectively having a snap-joining functionality. Claim 12, does not further limit the claims since the "metal sheet" limitations per claim #1 have been deleted.).

7. Claims 1, 4-6, 8-10 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Hansson et al. (US 6,465,046).

Hansson ('046) teaches a flooring system comprising a plurality of panels, at least one panel differing in aesthetic properties from another panel of the system, with carrying panels having edges (See FIG-1, col. 6, l. 65 to col. 7, l. 11 and col. 10, ll. 15-28 where a decorative surface element such as a map extends over several panels, thus providing for different aesthetic properties on the different panels since each panel has a different portion of the map.),



the edges being provided with means for joining (See FIG-1, entire FIG where the panel has tongues and grooves at the edges for joining the panels.), the carrying panel further being provided with an upper side and a lower side wherein the flooring system comprises a plurality of panels (See FIG-1, panels having upper/lower sides.) where each carrying panel is provided with an upper decorative surface on the upper side of the carrying panel and that the flooring system comprises panels having at least two of the decorative surfaces being different from each other and independently consisting of a decorative material including a thermosetting composite comprising cellulose and a

Art Unit: 1794

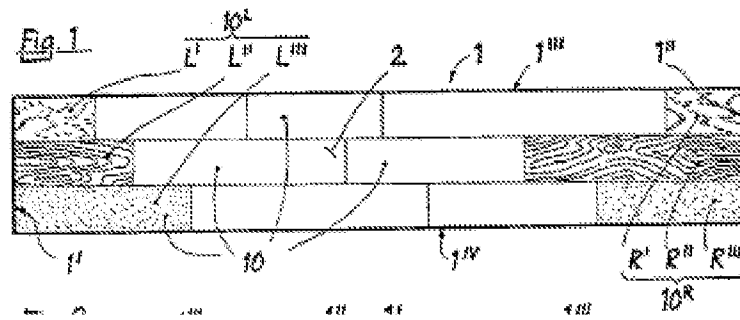
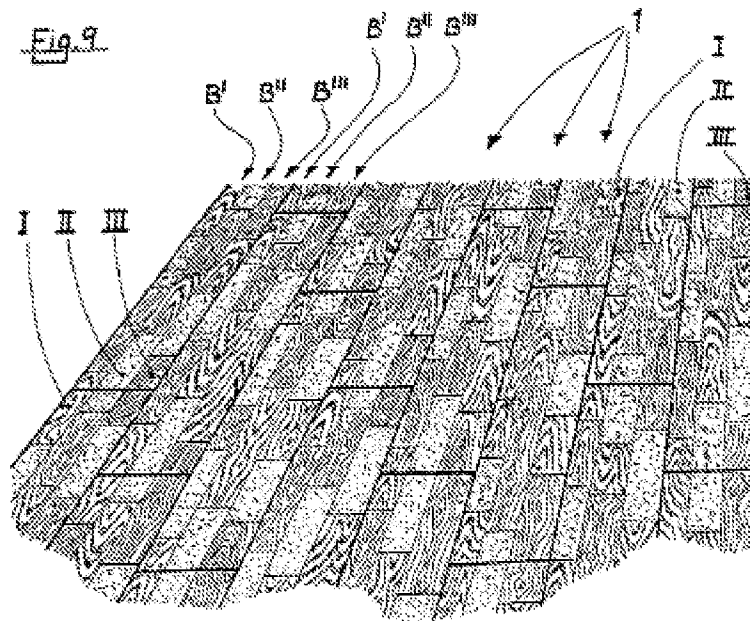
radiation curing melamine-formaldehyde amino resin with hard particles such as aluminum oxide, silicon oxide and silicon carbide, the particles having an average particles size in the range 50 nm-150  $\mu$ m (See FIG-1 and col. 5, ll. 5-10, 39-54, decorative surface #2. Claims 1 and 10 do not require each panel to only have one decorative surface and not two or more decorative surfaces. The claims do not require the materials of one surface to be different from that of another surface but rather for the system to have more than one panel and more than one surface. Two panels will clearly have two physically different surfaces since they are different panels.).

**Claim Rejections - 35 USC § 102/103**

8. Claims 1, 10, 13 and 16 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Sjoberg (US 2004/0170812).

Sjoberg ('812) teaches a flooring system comprising a plurality of panels with surface structures, each carrying panel with edges (See FIGs 9 and 1 where the panels with edges have different aesthetic appearances due to their surface structures I, II and III. Some of panels as illustrated in FIG-9 have five surface structures on a side while other panels have 4 panels on a side, thus, different appearances.),





the carrying panel further being provided with an upper side and a lower side wherein the flooring system comprises a plurality of panels (See FIGs 9 and 1 plurality of panels with upper and lower sides.), where each panel is provided with an upper decorative surface with the appearance of wood and the flooring system comprises panels with at least two of the decorative surfaces being different from each other and independently consisting of a decorative material including a thermosetting composite (See para. 7 and FIGs 9 and 1. Claims 1 and 10 do not require each panel to only have one decorative surface and not two or more decorative surfaces. The claims do not require

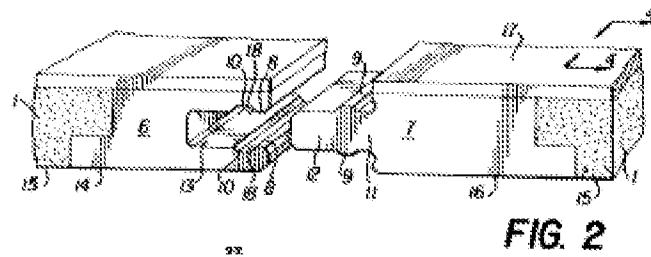
*the materials of one surface to be different from that of another surface but rather for the system to have more than one panel and more than one surface. Two panels will clearly have two physically different surfaces since they are different panels.) and inherently teaches edges being provided with means for joining and the surface being glossy (See FIGs 9 and 1 where the panels are joined by their edges having a means for joining and the surface is glossy.).*

In the alternative, a person having ordinary skill in the art would obviously appreciate or provide a means for joining the panels and glossy surface. Thus, a rejection under 35 USC 102/103 is proper (See MPEP 2112.).

***Claim Rejections - 35 USC § 103***

**9.** Claims 1-3, 7 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Martensson (US 6,397,547) in view of Sjoberg (US 2004/0170812).

Regarding claims 1, Martensson ('547) teaches a flooring system comprising a plurality of panels with the carrying panels having edges (See col. 3, ll. 31-42 and FIG-2, panel #1 with groove #6 and tongue #7.), the edges being provided with means for joining (See FIG-2, groove #10 and snapping web #9 for joining.), the carrying panel further being provided with an upper side and a lower side (See FIG-2, panels #1 and col. 2, ll. 30-63.) where each panel is provided with an upper decorative surface and the flooring system comprises panels with at least two of the decorative surfaces being a thermoplastic composite or a thermoplastic foil, (See col. 3, ll. 23-30 and FIG-2, #1.),

**FIG. 2**

however, fails to expressly disclose the panels being different and independently consisting of decorative material.

However, Sjöberg ('812) teaches a flooring system comprising a plurality of panels with at least one panel being different (See FIGs 9 and 1 where the panels with edges have different appearances due to their surface structures I, II and III. Some of panels as illustrated in FIG-9 have five surface structures on a side while other panels have 4 panels on a side, thus, different appearances. Claims 1 and 10 do not require each panel to only have one decorative surface and not two or more decorative surfaces. The claims do not require the materials of one surface to be different from that of another surface but rather for the system to have more than one panel and more than one surface. Two panels will clearly have two physically different surfaces since they are different panels.) for the purpose of providing panels with the desired décor or pattern (See para. 3.).

Therefore, it would have been obvious to a person having ordinary skill in the art at the time Applicant's invention was made to provide different panels as taught by Sjöberg ('812) in Martensson ('547) in order to provide panels with the desired décor or pattern.

Regarding claim 2, Martensson ('547) teaches where the edges are provided with snap-joining functionality (*See FIG-2, groove #10 and snapping web #9.*).

Regarding claim 3, Martensson ('547) teaches where the edges are provided with pre-applied glue (*See col. 2, ll. 43-47 and col. 4, ll. 6-11.*).

Regarding claim 7, Martensson ('547) teaches where the thermoplastic composite comprises thermoplastic materials selected being polyvinyl chloride or polyethylene (*See col. 3, ll. 23-27.*).

Regarding claim 11, Martensson ('547) teaches where the thermoplastic foil is polyvinyl chloride, polyethylene or polypropylene (*See col. 3, ll. 23-27.*).

**10.** Claims 4-9 and 11-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Grau (WO 03/060256) with evidence by Grau (US 2005/0115181) in view of Hansson et al. (US 6,465,046).

Grau ('256) teaches the flooring system discussed above, however, fails to expressly disclose at least two of the decorative surfaces being a thermosetting composite comprising cellulose and a radiation curing melamine-formaldehyde amino resin with hard particles such as aluminum oxide, silicon oxide and silicon carbide, the particles having an average particles size in the range 50 nm-150  $\mu$ m, thermoplastic materials such as PVC, polyolefins and other polymers, polymeric and metal foils.

However, Hansson ('046) teaches flooring panels where at least two of the decorative surfaces are a thermosetting composite comprising cellulose and a radiation curing melamine-formaldehyde amino resin with hard particles such as aluminum oxide, silicon oxide and silicon carbide, the particles having an average particles size in the

Art Unit: 1794

range 50 nm-150  $\mu$ m (*See FIG-1 and col. 5, ll. 5-10, 39-54, decorative surface #2.*) for the purpose of providing a stable, strong, abrasion resistant decorative panel (*See col. 7, ll. 12-15 and Abstract.*). Furthermore, selecting one of the above polymeric or metal materials for the panel surfaces would have been obvious depending on whether the panels are used outdoors, indoors, subject to heavy traffic, no traffic, consumer preference based on appearance or cost.

Therefore, it would have been obvious to a person having ordinary skill in the art at the time Applicant's invention was made to provide Grau's ('256) mixed flooring having panels with the above materials as taught by Hansson ('046) and the other polymeric/metal materials in order to provide a stable, strong, abrasion resistant decorative panel.

**11.** Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Grau (WO 03/060256) with evidence by Grau (US 2005/0115181) in view of Sjoberg et al. (WO 02/47906).

Grau ('256) teaches the flooring system discussed above, however, fails to expressly disclose panels wherein the elastomeric foil comprises thermoplastic elastomers.

However, as discussed above, Grau ('256) teaches its mixed flooring can be made of various materials based on user preference. Furthermore, Sjoberg's ('906) flooring panels made of elastomeric foil comprise thermoplastic elastomers (*See p. 2, ll. 15-22.*) for the purpose of providing a flooring panel that is resistant to abrasion, chemicals and sound (*See p. 1, ll. 1-7.*).

Therefore, it would have been obvious to a person having ordinary skill in the art at the time Applicant's invention was made to provide Grau's ('256) flooring system with panels made of thermoplastic elastomers as taught by Sjoberg ('906) in order to provide panels that are resistant to sound, abrasion and chemicals.

The phrase "wherein the elastomeric foil is placed on panels wherein the panels are intended to be walkways while the rest of the floor has a high-gloss wood design of thermosetting composite" in claim 15, lines 9-11 is deemed to be a statement with regard to the intended use and is not further limiting in so far as the structure is concerned (*see MPEP 2111.02*). Sjoberg's ('906) panels are clearly capable of being used as such. Since none of the surface is required to be a walkway no foil is required to be placed on the panels. Additionally, since none of the surface is required not to be a walkway then none of the high gloss design is required.

**12.** Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Grau (WO 03/060256) with evidence by Grau (US 2005/0115181) in view of Sjoberg et al. (US 2004/0812).

Grau ('256) teaches the flooring system discussed above, however, fails to expressly disclose the panels having a high gloss wood design.

However, Sjoberg ('812) teaches panels having a wood design (*See FIG-9.*) for the purpose of providing a decorative flooring (*See Abstract.*). Whether or not a glossy surface is provided is a matter of user preference and obvious to select

Therefore, it would have been obvious to provide a Grau's ('256) with decorative wood designs as taught by Sjoberg ('812) in order to provide a decorative flooring.

**13.** Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Grau (WO 03/060256) with evidence by Grau (US 2005/0115181).

Grau ('256) teaches the panels discussed above made of carpet, however, fails to expressly disclose the carpet being a needle loom carpet.

However, a person having ordinary skill in the art at the time Applicant's invention was made would know that there are many different types of carpet, with people having different preferences, which are functionally equivalent to each other including loom carpet. Thus, it is a matter of design choice and personal preference to select one type of carpet over another. Furthermore, Applicant has not set forth any criticality of using one type of carpet over another. Therefore, it would have been obvious to substitute Grau's ('181) generic carpet by needle loom carpet in order to provide a carpet that is aesthetically pleasing to the user.

**14.** Claims 17-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sjoberg (US 2004/0170812) in view of Bettinger (US 3,811,237).

Regarding claim 17, Sjoberg ('812) teaches the system discussed above, however, fails to expressly disclose where the fabric comprises a needle loom carpet.

However, Bettinger ('237) teaches that floor panels made of carpet and other materials such as vinyl are known (*See col. 4, ll. 33-61 and FIGS 4A, 10 and 1, panels #20. Furthermore, a needle loom carpet and Bettinger's ('237) carpet are interpreted as being interchangeable as Applicant has not presented any criticality of using one carpet over another.*) for the purpose of providing a flexible, resilient walking surface for an easily accessible, expandable flooring (*See col. 1, ll. 16-35.*). Furthermore, it was

Art Unit: 1794

known at the time Applicant's invention was made that in office environments people have a preference for flooring surfaces that are carpeted in some regions and smooth in the immediate vicinity of the desk chair so as allow for easy movement of a desk chair, especially one that has rollers.

Therefore, it would have been obvious to a person having ordinary skill in the art at the time Applicant's invention was made to provide floor panels with carpet as taught by Bettinger ('237) in Sjoberg ('812) in order to provide a flexible, resilient flooring that can easily be used in combination with other flooring materials.

Regarding claim 18, Sjoberg ('812) teaches a floor comprising a thermosetting composite (*See para. 7 and FIGs 9 and 1.*), however, fails to expressly disclose said materials being incorporated into the surface of the panels. However, it would it would have been obvious to incorporate said materials into the surface depending on how the flooring it used, whether the use is indoor, outdoor, high traffic, etc.

**15.** Claims 18-20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Grau (WO 03/060256) with evidence by Grau (US 2005/0115181) in view of Sjoberg et al. (WO 02/47906).

Grau ('256) teaches the panels discussed above, however, fails to expressly disclose the floor also comprising an elastomeric/thermoplastic foil or thermosetting materials.

However, Sjoberg ('906) teaches flooring comprising an elastomeric foil (*See p. 2, ll. 15-22.*) for the purpose of providing a floor with decreased sound production, especially when people walk on the floor with heels (*See p. 1, ll. 1-2 an 8-13.*).



Art Unit: 1794

Furthermore, the above materials are common materials used in flooring and it would have been obvious to use them based on where and how the floor is to be used, such as outdoors, indoors, heavy traffic areas, or in a way that is aesthetically pleasing to the user.

Therefore, it would have been obvious to a person having ordinary skill in the art to provide a flooring with an elastomeric foil as taught by Sjoberg ('906) and the other common flooring materials in Grau ('256) in order to provide quieter, pleasing floors.

**16.** Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sjoberg (US 2004/0170812) in view of Bettinger (US 3,811,237) and Martensson (US 6,397,547).

Sjoberg ('812) and Bettinger ('237) teach the system discussed above, however, fail to expressly disclose where the floor comprises a thermoplastic foil.

However, Martensson ('547) teaches a flooring comprising a thermoplastic foil (*See col. 3, ll. 23-27.*) for the purpose of providing a flooring that does not absorb water (*See col.3, ll. 28-30.*).

Therefore, it would have been obvious to provide a flooring made of thermoplastic foil as taught by Martensson ('547) in Sjoberg ('812) in order to provide a flooring that does not absorb water.

**17.** Claims 1 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sjoberg et al. (WO 02/47906) in view of Sjoberg (US 2004/0170812).

Sjoberg ('906) teaches a flooring system with a plurality of panels comprising a carrying panel with edges (*See p. 1, ll. 16-25 floor laminate with edges.*), the edges

Art Unit: 1794

being provided with means for joining (*See p. 1, ll. 16-25 wherein the panel clearly has edges and all edges can clearly be joined.*), the carrying panel further being provided with an upper side and a lower side (*See p. 1, ll. 16-25 wherein the plurality of panels have upper/lower sides.*), where each panel is provided with an upper decorative surface on the upper side of the panel and the flooring system comprises panels having at least two of the decorative surfaces being a thermoplastic composite or a thermoplastic foil and different (*See p. 2, ll. 15-22, where the foil is above the core.*), however, fails to expressly disclose the surfaces being different independently consisting of a decorative material.

However, Sjoberg ('812) teaches a flooring system comprising a plurality of panels with at least one panel differing from one another (*See FIGs 9 and 1 where the panels with edges have different aesthetic appearances due to their surface structures I, II and III. Some of panels as illustrated in FIG-9 have five surface structures on a side while other panels have 4 panels on a side, thus, different appearances. Claims 1 and 10 do not require each panel to only have one decorative surface and not two or more decorative surfaces. The claims do not require the materials of one surface to be different from that of another surface but rather for the system to have more than one panel and more than one surface. Two panels will clearly have two physically different surfaces since they are different panels.*) for the purpose of providing panels with the desired décor or pattern (*See para. 3.*).

Therefore, it would have been obvious to a person having ordinary skill in the art at the time Applicant's invention was made to provide different panels as taught by

Art Unit: 1794

Sjoberg ('812) in Sjoberg ('906) in order to provide panels with the desired décor or pattern.

**18.** Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sjoberg (US 2004/0170812) in view of Bettinger (US 3,811,237) and Sjoberg et al. (WO 02/47906).

Sjoberg ('812) and Bettinger ('237) teach the system discussed above, however, fail to expressly disclose where the floor also comprises an elastomeric foil.

However, Sjoberg ('906) teaches flooring comprising an elastomeric foil (*See p. 2, ll. 15-22.*) for the purpose of providing a floor with decreased sound production, especially when people walk on the floor with heels (*See p. 1, ll. 1-2 an 8-13.*).

Therefore, it would have been obvious to a person having ordinary skill in the art to provide a flooring with an elastomeric foil as taught by Sjoberg ('906) in Sjoberg ('812) in order to provide quieter floors.

#### **ANSWERS TO APPLICANT'S ARGUMENTS**

**19.** In response to Applicant's arguments (*pp. 5-12 of Applicant's Paper filed 2/9/2009*) regarding Bollinger and Pervan (US 2002/0007609), it is noted that said references are no longer cited, thus, all arguments regarding such are moot.

**20.** In response to Applicant's arguments (*pp. 5-6 of Applicant's Paper filed 2/9/2009*) regarding Grau (WO 03/060256) with evidence by Grau (US 2005/0115181), it is noted that Grau (US 2005/0115181) is not cited as prior art but rather the English equivalent to Grau ('256). If Applicant believes that the translation of Grau (WO 03/060256) is not

accurate as relied on then Applicant is advised to point out any such material discrepancy.

**21.** In response to Applicant's arguments (*pp. 5-12 of Applicant's Paper filed 2/9/2009*) regarding how the prior art do not teach the amended claims, it is noted that the independent claims have been significantly amended with the new teachings discussed in detail above. Furthermore, Applicant's arguments are substantially not commensurate in scope with the claims as Applicant appears to be arguing that the materials of the panels are different from each other, however, the claims do not set forth such limitations. The claims do not limit each panel to only having a single decorated surface or material.

**22.** In response to Applicant's arguments (*p. 6, para. 1 of Applicant's Paper filed 2/9/2009*) that Grau's(256) panels are identical and lateral flange #5 provides a panel with more than one surface, it is noted as disclosed in FIGs 1-2 that Grau's(256) system has a numerous panels made of different materials and shapes, thus, the panels are not identical. Furthermore, as discussed above, Applicant's claims do not limit each panel to a single decorated surface or material.

**23.** In response to Applicant's arguments (*p. 9, para. 4 of Applicant's Paper filed 2/9/2009*) that it would not have been obvious to use different flooring materials for outside surfaces or surfaces exposed to the weather as opposed to inside surfaces that are not exposed to the elements, it is noted that Applicant's arguments are not persuasive and it would have been obvious that depending on how the surfaces are used to select different materials.

**24.** In response to Applicant's arguments (*pp. 10-12 of Applicant's Paper filed 2/9/2009*) regarding the location of Sjoberg's foil, it is noted that it is clearly located above the core (*See p. 2, ll. 15-22.*).

**25.** Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brent T. O'Hern whose telephone number is (571)272-0496. The examiner can normally be reached on Monday-Thursday, 9:00-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Sample can be reached on (571) 272-1376. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1794

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/BTO/

Brent T. O'Hern

Examiner

Art Unit 1794

April 6, 2009

/Elizabeth M. Cole/

Primary Examiner, Art Unit 1794